

The opinion in support of the remand being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte WILLIAM D. MORGAN

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Appeal No. 2002-0385  
Application No. 08/828,330<sup>1</sup>

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REMAND

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**MAILED**

**MAR 15 2002**

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice-Chief Administrative Patent Judge, and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for appropriate action.

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<sup>1</sup> Application filed March 28, 1997, for reissue of U.S. Patent No. 5,400,549 (Application No. 08/139,835, filed October 22, 1993), which patent issued on March 28, 1995.

### BACKGROUND

1. A review of the file record indicates that claims 4 to 12, 14 to 16 and 18 to 48 stand rejected under 35 U.S.C. § 251 as being "improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." Specifically, the examiner provided (answer, p. 4) that the basis for this rejection is that

[t]he examiner included these limitations [the limitations being deleted in this reissue application] in his reasons for allowance [sic, reasons for the indication of allowable subject matter] in paper #2 mailed 09/12/94 of the patented file. Applicant failed to present a counter statement or comment as to the examiner's reasons for allowance [sic, reasons for the indication of allowable subject matter], and permitted the claim to issue.<sup>[2]</sup> The omitted limitations are thus established as relating to subject matter previously surrendered.

2. The Board of Patent Appeals and Interferences has rendered the following three decisions relating to the issue raised in the present appeal:

(1) Ex parte Yamaguchi, decided July 31, 2001, on reissue Application No. 09/296,102, which has published at 61 USPQ2d 1043 and has been made publically available on our web site at <http://www.uspto.gov/web/offices/com/sol/foia/bpai/fd011596.pdf>;

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<sup>2</sup> The claim that issued (i.e., claim 1) was never rejected over prior art. In the first Office action, original claim 1 was rejected as being indefinite and the examiner stated that claim 1 would be allowable if amended to overcome the indefiniteness rejection and provided reasons for the indication of allowable subject matter. The applicant then filed an amendment to claim to clarify the points of indefiniteness cited by the examiner. In response to that amendment, the examiner rewrote claim 1 in an Examiner's Amendment and allowed claim 1.

(2) Ex parte Brugman, decided December 18, 2001, on reissue Application No.

09/219,475; and

(3) Ex parte Howard, decided January 23, 2002, on reissue Application No. 09/521,188.<sup>3</sup>

#### ACTION

We remand the application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 is still appropriate in light of the above-noted decisions and for such further action as may be appropriate.

#### CONCLUSION


This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, August 2001).

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<sup>3</sup> These are the only decisions that we are aware of dealing with the issue of whether an examiner's statement of reasons for allowance/allowability in a first Office action constitutes a surrender under either the recapture rule or prosecution history estoppel. Copies of all three decisions are attached hereto for the examiner's convenience. The Board of Patent Appeals and Interferences has now determined that the decision set forth in the opinion in Ex parte Yamaguchi is binding precedent of the Board.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

REMANDED

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

  
GARY V. HARKCOM  
Vice-Chief Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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Page 5

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